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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,243	01/16/2002	Stephen R. Dohm	ITWO:0026	6362

7590 08/19/2004

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EXAMINER

SAETHER, FLEMMING

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/050,243

Applicant(s)

DOHM, STEPHEN R.

Examiner

Flemming Saether

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13, 15-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 15-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

Claims 1-4, 6-13 and 15-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US 4,193,434) in view of Bernoni (US 5,584,628). In the embodiment of Figs. 1 and 2, Wagner discloses a fastener assembly comprising a stemmed washer (12) having a standoff portion (30) and a spring washer portion (28). The spring washer portion is formed at an acute angle relative to standoff portion and having a generally conical shape which is inherently elastically deformable since it is disclosed as a spring. Wagner shows an externally threaded fastener retained to the stemmed washer but, does not disclose an internally threaded fastener. Bernoni discloses a fastener assembly wherein a fastener is retained to a washer and teaches to interchange an internally threaded fastener as seen in Fig. 5 for and externally threaded fastener as seen in Figs. 1 and 3. Accordingly, at the time the invention was made, the skilled artisan would have recognized to substitute the externally threaded fastener disclosed in Wagner with an internally threaded fastener in view of the teaching of Bernoni such that the assembly could be used in applications requiring an internally threaded fastener. Bernoni further discloses the fastener to have a flange (not labeled) and the washer to have a retaining portion comprising a skirt deformed inwardly to capture the flange (at 14) such that the fastener is rotatable relative to the washer. At the time the invention was made, the person of ordinary skill in the art would have recognized the retaining skirt as disclosed in Bernoni as an optimal means of retaining an internally threaded fastener in Wagner. The method would have been inherent in the combination.

Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner in view of Bernoni and further in view of applicant's admitted prior art (APA). As described above, Wagner as modified by Bernoni discloses a fastener assembly including a stemmed washer retained to an internally threaded fastener. However, modified Wagner does not disclose the joint wherein the stemmed, or standoff, portion of the washer extends through first and second members. In the "*Background of the invention*" applicant described a fastener assembly wherein standoff portion of a stemmed washer, extends through "one or more compressible materials" such that a traditional nut and bolt with associated washers are located on opposite sides. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to use the assembly of modified Wagner in an application as described in the APA wherein it is required to secure one or more compressible materials together. The assembly of modified Wagner is superior in that it provides for the spring washer on the standoff and for the standoff to be preassembled to the fastener. The spring washer would provide a biasing for a secure connection and the preassembly would facilitate assembly with the materials.

In Response to Applicant's Remarks:

As a formality, it was noted that claims 9 and 21 should have been described as -
-(currently amended)--.

As should have been recognized above, the Wagner reference has been applied to replace the Van Boven reference. However, it should not be construed that this indicates agreement with applicant's arguments. The Wagner reference only avoids some of applicant's arguments to simplify the issues. Specifically, in Wagner there is no relative axial movement between the washer and fastener thus, that argument provided by applicant supporting unobviousness is now moot.

In response to applicant's arguments that the prior art fails to teach certain features of the claims the examiner disagrees because once the combination was made, all the features of the claims would be taught. As addressed in the above rejection Wagner (and Van Boven) teaches the spring washer at an acute angle and edge of a washer being bent over a flange to retain the washer thereto is taught in Bernoni's Fig. 5.

As applicant's arguments regarding the lack of suggestion to combine may be applied to the new rejection, the examiner disagrees that there lacks motivation for the combination. The examiner agrees that it would not be logical to provide an inwardly deformed portion of the outer perimeter of the washer as a retaining means to Wagner at least not without first doing away with the retaining means already employed in Wagner and further concedes that the motivation to do that would at best be questionable. However, the retaining means currently employed in Wagner would only work with a bolt since it requires the shaft of the bolt for the retaining means. Now, as


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discussed in the above rejection and in the previous office action, the combination includes replacing the bolt with a nut (as taught in Bernoni) and once the bolt is replaced, the currently employed retaining means would be inoperative requiring a new retaining means which Bernoni is again relied upon to teach. Indeed, the retaining means in Bernoni is optimal for use with a *nut*.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Flemming Saether
Primary Examiner
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